

REMARKS

Claims 11-19, 40-48 and 50-53 are pending. Claims 11-19, 40-48 and 50-53 stand rejected. By virtue of this response, no claims are amended, cancelled, or added. Accordingly, claims 11-19, 40-48, and 50-53 are currently under consideration. For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Double Patenting

Claims 11-19, 40-48, and 50-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 70-78, 81 and 108 of copending Application No. 09/935,462.

Upon the indication of allowable subject matter in the present application, Applicants may file a terminal disclaimer or cancel the conflicting claims in the copending Application No. 09/935,462 to over come this provisional obviousness-type double patenting rejection.

Applicants submit, however, that claim 11 recites a "reflective layer" and claim 40 recites a surface of a substrate that "is optically reflective." These features are not recited by the claims of copending Application No. 09/935,462 identified by the Examiner. Accordingly, Applicants submit that the claims of the present application are not obvious in light of the claims of copending Application No. 09/935,462. Additionally, Applicants direct the Examiner to the arguments presented below in response to the rejection over application 09/935,462, and submit the rejection should be withdrawn for the reasons stated below as well.

Claim Rejections under 35 USC §102

Claims 11-19, 40-48, and 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0044579 A1 to Dhar et al. (hereinafter "Dhar").

Applicants respectfully traverse the rejection and submit that Dhar does not disclose each and every feature of independent claim 11 or independent claim 40 and the rejection should therefore be withdrawn.

With regard to claim 11, Applicants submit that Dhar does not disclose or suggest a multilayer optical article comprising, *inter alia*, a first substrate, a second substrate, a third substrate, and “a reflective layer,” as recited by claim 11. See, for example, Figs. 5a and 5b, which illustrate a multilayer optical article including a reflective layer 508 in addition to first, second, and third substrates 504, 506, 514. This feature of claim 11 (in particular, a reflective layer) is not alleged to be shown in the Office Action; at best the Examiner has argued that the a first, second, and third substrate are disclosed, but has failed to allege or identify a reflective layer as recited by claim 11. The Examiner’s assertion that Dhar discloses “a diffraction or relief pattern on the first substrate,” (even if true) fails to disclose or suggest a “reflective layer,” in addition to the first, second, and third substrates as presently recited. Additionally, a diffraction or relief pattern on a substrate does not necessarily result in reflection or an optically reflective layer/surface, nor has this been shown by the Examiner. Accordingly, the rejection to claim 11 should be withdrawn and claim 11 (and claims 12-19 and 50-51 which depend therefrom) allowed.

With regard to claim 40, Applicants submit that Dhar does not disclose or suggest a multilayer optical article comprising, *inter alia*, a first substrate wherein “the first surface is optically reflective,” as recited by claim 40. The Examiner states that Dhar teaches “a diffraction or relief pattern on the first substrate, it functions as having an ‘optically reflective’ first surface...” As stated above a diffraction or relief pattern on a substrate does not necessarily result in an optically reflective surface.

Furthermore, regarding the preamble recitation of claim 40 to a multilayer reflective holographic storage system, the Examiner states “the same layers, materials, and values are taught and thus a different naming of the essential elements do not make the product different.” Applicants disagree that the same layers, materials, and values are taught, and even if the same layers, materials, and values are taught, that assertion alone is insufficient to sustain the rejection. Initially,

Dhar fails to disclose or suggest first, second, and third substrates and a reflective material such as a reflective coating or layer such that the “first surface [of the first substrate] is optically reflective,” as clearly recited by claim 40. Further, Dhar does not, in fact, disclose or suggest the same materials as the present application. For example, the present application describes that a “reflective material formed on the substrate.... may be aluminum, gold, copper, or any other suitable material.” (see, e.g., paragraph [0045]). Dhar does not disclose or suggest these materials. Accordingly, an optically reflective property as recited by claim 40 is not disclosed by Dhar and the rejection should be withdrawn.

In this light, Applicants submit that the rejection to claim 40 (and perhaps to claim 11 as well) improperly relies on inherency (i.e., the Examiner appears to be taking the position that certain features are inherently present based on similar materials etc.) to meet the features of the present claims and should therefore be withdrawn. Reliance on inherency when the reference is silent about the asserted inherent characteristic requires a rationale or evidence showing inherency. MPEP § 2112. The rationale or evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (emphasis added); MPEP §§ 2112, 2131.01. In this instance, Dhar is silent regarding a reflective material or surface. Further, the Examiner has clearly failed to show that a reflective material or surface is necessarily present by the disclosure of materials, layers, values, etc. Therefore, Dhar fails to show each and every feature of claim 40 and the rejection should be withdrawn.

Accordingly, for at least these reasons, the rejections to claims 11 and 40 should be withdrawn and all pending claims allowed.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 495812001900. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By 

Christopher B. Eide

Registration No.: 48,375

MORRISON & FOERSTER LLP

755 Page Mill Road

Palo Alto, California 94304-1018

(650) 813-5720